

The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

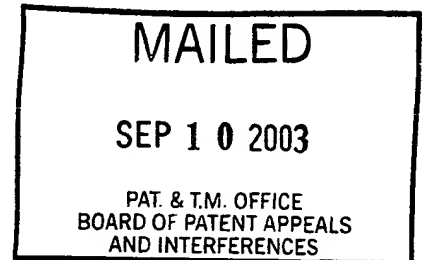
Ex parte SUNDARAM RAMAKESAVAN

Appeal No. 2002-0336
Application No. 09/234,559

ON BRIEF

Before THOMAS, KRASS, and GROSS, Administrative Patent Judges.

KRASS, Administrative Patent Judge.



DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-26, directed to a
system for providing video on demand.

In particular, when a user wishes to pause the play of a video, a controller receives the request to pause and automatically requests a code to enable video play to be resumed at a later time.

Representative independent claim 1 is reproduced as follows:

1. A receiver for receiving video information from a video transmitter comprising:
 - a storage medium for storing video information received by a receiver;
 - a decryption engine to decrypt stored video information; and
 - a controller to control the storage medium and the decryption engine and request decryption information for the engine, said controller to control the play of video, to receive a request to pause the play of said video and to automatically request a code to enable video play to be resumed at a later time.

The examiner relies on the following reference:

Russo

6,025,868

Feb. 15, 2000
(filed Apr. 7, 1997)

Claims 1-26 stand rejected under 35 U.S.C. §103 as unpatentable over Russo.

Reference is made to the brief and answer for the respective positions of appellant and the examiner.

OPINION

It is the examiner's position that Russo arranges a video-on-demand system which involves billing, wherein the programs which are user-selected are stored at the user's station, a storage medium 110 and a decrypting engine (descrambling element 114). The program reproduction is carried out using various user interfaces which access a controller 150 by a control bus 154 and a data bus 152 (see Paper No. 5, page 2).

While Russo does not explicitly disclose the claimed "pause" feature, the examiner contends that such a feature is suggested by Russo since Russo "accounts for the situation where if the viewer cannot finish a program for viewing once it has been selected, the system will keep track of where the user left off and pick up at that point (col. 11, lines 14-17), which essentially describes a pause-type condition" (Paper No. 5-page 2).

We agree with the examiner that Russo clearly suggests a "pause" feature, permitting a user to restart the program at the point where the user left off. However, the instant claims do not merely require a "pause" feature. They require a specific way to restart the program at a later time, after the pause. In particular, each of the claims on appeal requires a controller to request a "code" to enable video play at a later time.

While the examiner does not contend that Russo discloses such a "code," the examiner does contend that it would have been "obvious to consider such a feature as a pause function, whereby the controller 150 would recognize this command by an inherent code, as a separate command from a resume or play command..." (Paper No. 5-page 2, emphasis added).

The mere fact that a certain thing MAY result from a given set of circumstances is not sufficient to establish inherency. In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993). The examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teaching of the prior art. Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Interf. 1990).

The examiner has not shown that the use of a code for pausing and restarting a video, especially automatically requesting a code, is inherent in Russo because there may be many different ways to achieve Russo's intended result, i.e., to suspend playback and resume playback at a later time without additional charge, without resorting to the use of a code, as claimed. Accordingly, since the use of such a "code" is not the only way in which the claimed result may be achieved, and there are other ways to implement the pause and restore features, the examiner has not established a reasonable case for a conclusion of inherency. In fact, even if the use of a "code" for enabling video play to be resumed could be considered inherent, the claims require the controller to "automatically request a code..." and the "automatic" request for such a code has not been shown to be suggested by Russo nor has such an "automatic" request been shown by the examiner to be inherent in any way.

The examiner's response, at pages 5-7 of the answer, as to what Russo "*must*" be doing, even though Russo does not disclose these things, is mere speculation upon which a valid rejection under 35 U.S.C. §103 may not be based.

Since the automatic retrieval of a code to enable video play to be resumed at a later time does not necessarily flow from Russo's teaching of suspending a playback

The examiner's decision rejecting claims 1-26 under 35 U.S.C. §103 is reversed.

EAK/yr

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